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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/864,457	05/25/2001	Hiroshi Tanaka	Q64695	3821

7590

04/04/2006

SUGHRUE, MION, ZINN, MACPEAK & SEAS, PLLC  
2100 Pennsylvania Avenue, N.W.  
Washington, DC 20037-3202

EXAMINER

CHANNAVAJALA, SRIRAMA T

ART UNIT PAPER NUMBER

2166

DATE MAILED: 04/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/864,457

Applicant(s)

TANAKA ET AL.

Examiner

Srirama Channavajjala

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                                    | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

**Response to RCE**

1. Claims 1-9 pending in this application.
2. Claims 1,2,4 have been amended [3/20/2006].
3. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/20/2006 has been entered, and a non-final Office action is as follows
4. Examiner acknowledges applicant's amendment under 37 CFR 1.111 filed on 7/25/2005.
5. In view of the appeal Brief filed on 10/22/2004, PROSECUTION IS HEREBY REOPENED, a non-final office action was mailed on 2/11/2005.
6. Examiner acknowledges applicant's appeal brief filed on 10/22/2004.
7. Examiner acknowledges applicant's amendment filed on 4/6/2004, paper no.5.
8. Claims 1-2, 4 have been amended, paper no. # 5.
9. Claims 7-9 have been added, paper no. # 5.

***Drawings***

10. The drawings filed on 5/25/2001 are acceptable for examination.

It is however, noted that in the present application fails to provide every feature of the invention specified in the claims for example **claim 1** is directed to "**a service supply method, in which a customer receiving services and at least one of a plurality of suppliers.....steps of: prior to selecting a supplier, acquiring supplier information.....acquiring customer information.....allowing the customer who desires the supply of said desired.....customer information**", although drawing fig 1-5 suggests "customer information, supplier information acquiring within "management center", it is not clear as to how "general practitioner, element 80", "medical specialist" element 90 and relationship between "accounting means, database element 20 related to claims 1-9.

Therefore, each specific function must be shown or the feature(s) canceled from the claim(s), A proposed drawing are required in reply to the Office action.

**No new matter should be entered.**

***Priority***

11. Acknowledgment is made of applicant's claim for priority under 35 U.S.C.

119(a)-(d) based upon an application [SI.No.# **2000-156603**] filed in Japan on 5/26/2000

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

12. Claims 1-9 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The invention as claimed in claims 1-2,4 and interpreted in light of the specification particularly page 2-5, 8-14, 19-20 is directed to a acquiring supplier information, location of each supplier, fee constituting good value for the supply of the service, acquiring customer information concerning the service desired by the customer, further in the specification page 7-8, fig 1, is directed to service system comprises a management center, database may be provided in the management center element 10, operator of the management center acquires the information by telephone or the link [spec page 8, line 17-19] which is a combination of hardware and software or software per say, both system and method performing a mathematical algorithm, formula, or calculation related to "supplier information concerning at least a time.....service" [claim 1-2,4], and as such the claimed invention is subject to the test of State Street, 149 F.3d at 1373-74, 47 USPQ2d at 1601-02. Specifically State Street sets forth that the claimed invention must produce a ***"useful, concrete and tangible result."*** The Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility states in section IV C. 2 b. (2) (on page 21 in the PDF format):

The tangible requirement does not necessarily mean that a claim must either be tied to a particular machine or apparatus or must operate to change

articles or materials to a different state or thing. However, the tangible requirement does require that the claim must recite more than a § 101 judicial exception, in that the process claim must set forth a practical application of that § 101 judicial exception to produce a real-world result. Benson, 409 U.S. at 71-72, 175 USPQ at 676-77 (invention ineligible because had “no substantial practical application.”).

Claims 1-2,4 have the result of producing time schedule related plurality of supplier information allowing customer who desire the services, however the claims do not specify that the result neither stored nor output is displayed to a user or otherwise used in the real world especially claim 1,4, although claim 2 “storing the acquired supplier information in a database”, but **does not output useful, concrete and tangible** ,Also, examiner notes that “allowing the customer .....” [claim 1,claim 4] is not a positive recitation of a real world result. Thus the claimed result is not tangible and thus the claimed result is not a “useful, concrete and tangible result.” The court in State Street noted that the claimed invention in Alappat constituted a practical application of an abstract idea because it produced *a useful, concrete and tangible result* the display of a smoothed heart beat to a system user. The Federal Circuit further ruled that it is of little relevance whether a claim is directed to a machine or process for the purpose of a § 101 analysis. AT&T, 172 F.3d at 1358, 50 USPQ2d at 1451 (see the Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility, Annex II).

The examiner reviewed the specification but was unable to find a practical real-world use of the result (for example: claim 1, claim 4, allowing the customer who desires

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the .....acquired customer information ). If the applicant is able to find one and inserts it into the claims provide the location the element[s] is found in the specification.

In the above analysis of claims 1-2,4, dependent claims 3,5-9 also rejected on that basis.

Note: examiner treats claim 3 is dependent from independent claim 1;

Claim 6 is dependent from independent claim 4 in the present office action.

See for further information:

<<http://www.uspto.gov/web/offices/pac/dapp/ogsheet.html>>

### ***Claim Rejections - 35 USC § 102***

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

**14. Claims 1- 2,4-5,7-9 are rejected under 35 U.S.C. 102(e) as being anticipated by Anderson et al. [hereafter Anderson], US Pub.No. 2001/0042023 filed Jan 22, 2001, based on Non-provisional of provisional application 60/177,327 filed on Jan 21, 2000.**

15. As to claim 1, Anderson teaches a system which including 'a service supply method, in which a customer receiving services and at least one of a plurality of supplier capable of supplying a service desired by the customers are linked, and supply of said desired service from said supplier to said customer is enabled' [see Abstract, page 1, col 1, 0004, 0007,0011], Anderson is directed to product fulfillment system, more specifically, buyers or customers place orders to multiple suppliers from a remote computer connected via network as detailed page 1, 0004; plurality of supplier capable of supplying a service corresponds to list of eligible suppliers selected as detailed in page 1, 0011;

'acquiring supplier information concerning at least a time when each of said supplier can supply said service via network' [page 1, 0011-0012], Anderson specifically teaches supplier is selected from a list eligible supplier based on not only "predetermined time period" but also the specific selection criteria for example nearest supplier, buyer's or customer's shipping address and like[see page 1, 0011];

' prior to selecting a supplier [[Anderson specifically teaches multiple eligible suppliers as detailed in page 1, 0008], acquiring customer information concerning said service desired by said customer '[page 1, col 2, 0021, line 1-7], acquiring customer



information concerning said service desired by said customer corresponds to customer specified desired services for example completion of the order by the nearest eligible supplier as detailed in page 1, col 2, 0021;

'allowing the customer who desires the supply of said desired service and the supplier capable of supplying the desired service to correspond with each other based on said supplier information and said acquire customer information' [page 2, col 1, 0028-0029]], Anderson specifically teaches nearest eligible supplier is chosen, if the nearest eligible supplier does not respond in a predetermined time, next nearest eligible suppliers see the item ordered and the order is considered filled if the nearest eligible supplier responds that all items are available as detailed in page 2, col 1, 0028.

16. As to claim 2, Anderson teaches a system which including 'a service supply method, in which a customer receiving services and at least one of a plurality of suppliers capable of supplying a service desired by the customer are linked and supply of said desired service from said supplier to said customer is enabled' [see Abstract, page 1, col 1, 0004, 0007, 0011], Anderson is directed to product fulfillment system, more specifically, buyers or customers place orders to multiple suppliers from a remote computer connected via network as detailed page 1, 0004; plurality of supplier capable of supplying a service corresponds to list of eligible suppliers selected as detailed in page 1, 0011;

' prior to selecting a supplier [[Anderson specifically teaches multiple eligible suppliers as detailed in page 1, 0008] 'acquiring supplier information concerning at least

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a time when each of said suppliers can supply said service'[ page 1, 0011-0012],

Anderson specifically teaches supplier is selected from a list eligible supplier based on not only "predetermined time period" but also the specific selection criteria for example nearest supplier, buyer's or customer's shipping address and like[see page 1, 0011];

'storing the acquired supplier information in a database' [see fig 1, page 1, 0007]

'acquiring customer information concerning said service desired by said customer' [page 1, col 2, 0021, line 1-7], acquiring customer information concerning said service desired by said customer corresponds to customer specified desired services for example completion of the order by the nearest eligible supplier as detailed in page 1, col 2, 0021;

'allowing the customer who desires the supply of said desired service and the supplier capable of supplying the desired service to correspond with each other based on said supplier information and said acquire customer information' [page 2, col 1, 0028-0029]], Anderson specifically teaches nearest eligible supplier is chosen, if the nearest eligible supplier does not respond in a predetermined time, next nearest eligible suppliers see the item ordered and the order is considered filled if the nearest eligible supplier responds that all items are available as detailed in page 2, col 1, 0028.

17. As to claim 4, Anderson teaches a system which including 'a service supply system, in which a customer receiving services and at least one of a plurality of suppliers capable of supplying a service desired by the customer are linked, and supply of said desired service from the supplier to said customer is enabled' enabled' [see Abstract, page 1, col 1, 0004, 0007,0011], Anderson is directed to product fulfillment system, more specifically, buyers or customers place orders to multiple suppliers from a remote computer connected via network as detailed page 1, 0004; plurality of supplier capable of supplying a service corresponds to list of eligible suppliers selected as detailed in page 1, 0011;

'supplier information acquiring means for acquiring supplier information concerning at least a time when each of said suppliers can supply said service' [ page 1, 0011-0012], Anderson specifically teaches supplier is selected from a list eligible supplier based on not only "predetermined time period" but also the specific selection criteria for example nearest supplier, buyer's or customer's shipping address and like[see page 1, 0011];, wherein said supplier information is acquired prior to selecting a supplier'[[Anderson specifically teaches multiple eligible suppliers as detailed in page 1, 0008]

'customer information acquiring means for acquiring customer information concerning said service desired by said customer' [page 1, col 2, 0021, line 1-7], acquiring customer information concerning said service desired by said customer corresponds to customer specified desired services for example completion of the order by the nearest eligible supplier as detailed in page 1, col 2, 0021;

'matching means for allowing the customer who desires the supply of said desired service and the supplier capable of supplying the desired service to correspond with each other based on said supplier information and said acquired customer information'[page 2, col 1, 0028-0029]], Anderson specifically teaches nearest eligible supplier is chosen, if the nearest eligible supplier does not respond in a predetermined time, next nearest eligible suppliers see the item ordered and the order is considered filled if the nearest eligible supplier responds that all items are available as detailed in page 2, col 1, 0028.

18. As to claim 5, Anderson disclosed 'a database for storing said supplier information' [see fig 1, page 1, 0007].

19. As to claim 7-9, Anderson disclosed 'supplier information further concerns a quality of service that each of said suppliers can supply'page 2, 0037, 'a location of each of said suppliers and/or a fee for the supply of said service' [page 2, 0039-0040].

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

***20. Claim 3,6, is rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson et al. [hereafter Anderson], US Pub. No. 2001/0042023 filed Jan 22, 2001, based on Non-provisional of provisional application 60/177,327 filed on Jan 21, 2000 as applied to claims 2,4 above, and further in view of Wilkinson et al. [hereafter Wilkinson], US Pub. No. 2001/0034615 based on Non-provisional of provisional application No. 60/189,494 filed on March 15, 2000***

21. As to claim 3, 6, Anderson does not specifically teach 'service is a service associated with medical attention or a service associated with care', although Anderson teaches customer chooses or selects from a list of eligible suppliers to deliver the ordered product in a specific time period [see Abstract, page 1, col 1, 0011-0012]. On the other hand, Wilkinson disclosed 'service is a service associated with medical attention or a service associated with care' [page 1, col 2, 0006, page 6, 0049-0050] .

It would have been obvious to one of the ordinary skill in the art at the time of applicant's invention to incorporate the teachings of Wilkinson et al. into product fulfillment system of Anderson's reference, because that would have allowed users of Anderson to provide eligible providers to offer valuable medical services to required

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customers or patients, further allowing to integrate, interactively exchanging medical information between consumer and suppliers such that personalized medical information made available to any assessment or diagnosis, thus bringing the advantages of "multiple providers can form a "care team" access to patient data to facilitate collaboration among the provides as suggested by Wilkinson [page 1, 0006].

### ***Response to Arguments***

22. Applicant's arguments, filed on 3/20/2006, with respect to the rejection of claims 1-9 have been considered, but are moot in view of the above office action.

### ***Conclusion***


#### **The prior art made of record**

- |    |            |              |
|----|------------|--------------|
| a. | US Pub No. | 2001/0042023 |
| b. | US Pub No. | 2001/0034615 |

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Srirama Channavajjala whose telephone number is 571-272-4108. The examiner can normally be reached on Monday-Friday from 8:00 AM to 5:30 PM Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alam, Hosain, T, can be reached on (571) 272-3978. The fax phone numbers for the organization where the application or proceeding is assigned is 703/872-9306 Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free)

SC  
Patent Examiner.  
March 28, 2006.

  
SRIRAMA CHANNAVAJJALA  
PRIMARY EXAMINER